

**REMARKS**

In the Office Action mailed April 29, 2002, the examiner (i) rejected claims 1-2, 9-10, 20, 22-23, 26-30, 36-38, 41-43, 45, 47, and 51-53 under 35 U.S.C. § 102(e), and (ii) rejected claims 3-8, 11-16, 18-19, 21, 24-25, 31-35, 39-40, 44, and 46 under 35 U.S.C. § 103(a). Claims 1, 20, 26, and 30 have been amended solely for the purpose of clarifying the claims.

Claim 1 previously recited, "a commercial message server connected to the data network" as shown in Figure 5A. Claim 1 has been amended to no longer recite the commercial server being connected to the data network. Applicants submit that no new matter has been added as support for the amendment may be found in at least Figure 3A, Figure 4A, lines 4-7 on page 31 of the specification, and in lines 11-13 on page 34 of the specification.

Claim 20 previously recited, "...identify a first user ... ." Claim 20 has been amended to recite 'identify a user' instead of reciting 'identify a first user'. Applicants submit that no new matter has been added, as support for the amendment may be found in the specification at least on: 1) lines 28-29 on page 7, 2) lines 17-18 on page 8, and 3) lines 24-29 on page 17.

Applicants have reviewed the Examiner's remarks and the cited references and respectfully submit that the cited references fail to teach or suggest all of the elements of Applicant's presently claimed invention. Therefore, Applicants respectfully traverse the rejections and request favorable reconsideration in view of the following remarks.

**CLAIM REJECTIONS – 35 U.S.C. § 102(e)****Rejections under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,999,965**

The Examiner rejected claims 1-2, 9-10, 20, 22-23, 26-30, 36-38, 41-43, 45, 47, and 51-53 under 35 U.S.C. § 102(e) as being anticipated by Kelly, U.S. Patent Number 5,999,965 (hereinafter Kelly).

Kelly discloses an Automatic Call Distribution (ACD) server 400 that connects to a packet-switched data network 440. The ACD server 400 goes online after exchanging ONLINE packets with the connection server 410. Kelly also discloses that the caller process 520 transmits a CONNECTREQ package to the connection server 510 that subsequently transmits a CONNECTACK packet back to the caller process 520. After the ACD server and caller process are connected to the connection server, the caller process can initiate a call to an agent 530 serviced by the ACD server.

**CLAIMS 1, 2, 9, and 10**

With respect to Examiner's rejection of claim 1, 2, 9 and 10, Applicants respectfully submit that Kelly does not disclose communicating "at least one commercial message request with the commercial message server."

Kelly states "while a caller process 520 is in queue, ACD server 500 enables the caller process keypad and may transmit periodic audio messages such as "Please wait for next available agent or press 1 to request a callback," and/or other information such as music, advertisements, stock quotes, etc." (Kelly, Col. 16 lines 25-30). In this passage, Kelly discloses an audio message to request a callback and that the Automatic Call Distribution server may transmit advertisements periodically. Kelly does not disclose a commercial message request in this passage.

The Examiner argued in the Office Action that the Automatic Call Distribution server is a commercial message server. April 29 Office Action, pg. 2, ¶ 3.

Kelly discloses the transmission of various types of packets with the Automatic Call Distribution server. Those packets have a variety of functions regarding telephony service. However, none of the packets transmitted to the Automatic Call Distribution server disclosed in Kelly are commercial message requests with a commercial message server.

Therefore, Kelly does not disclose communicating "at least one commercial message request with the commercial message server" and Applicants respectfully submit that the independent claim 1 and dependent claims 2 and 9-10 are allowable.

#### **CLAIMS 20, 22-23, 26-29**

With respect to the Examiner's rejection of claims 20, 22-23, and 26-29, Applicants respectfully submit that Kelly does not disclose a commercial message request. Claims 20 and 26 recite sending/communicating at least one commercial message request. Kelly does not anticipate the independent claims 20 and 26 for the same reasons stated above with respect to claim 1 and because none of the other packets disclosed by Kelly are commercial message requests. Consequently, Kelly does not anticipate dependent claims 22-23; 27-29. Applicants respectfully submit that claims 20, 22-23, and 26-29 should be allowed.

#### **CLAIMS 30 and 36-38**

With respect to the Examiner's rejection of claims 30 and 36-38, Applicants respectfully submit that Kelly does not disclose a signaling stack to send a request comprising a callee identifier. Kelly uses the automatic call distribution server and connection server to obtain the callee's IP address to complete the connection from the caller to the agents within the enterprise. See Col. 8, lines 19-55. Kelly does not teach sending a request with the callee identifier. Therefore, Kelly does not anticipate the independent claim 30 nor dependent claims 36-38.

#### **CLAIMS 41-43, & 45**

With respect to the Examiner's rejection of claims 41-43 and 45, the Examiner argued on page 2 of the Office Action that the Automatic Call Distribution server is a commercial message server. Applicants respectfully disagree. The Automatic Call Distribution server is not a

commercial message server as claimed in claim 41. For example, Kelly does not disclose "a telephony connection server interface to receive connection information from a telephony connection server, the connection information comprising at least one user identifier for at least one party to a telephone call ..." as recited in claim 41.

The automatic call distribution server in Kelly routes calls to a plurality of agent processes as they become available. *See Kelly, Abstract.* A caller process in the calling agent requests a connection (CONNECTREQ) from a connection server. The connection server then provides the caller process with a reference to a group organization and the IP address of the automatic call distribution center. The automatic call distribution server then routes calls to the next available agent. If an agent is not available, the automatic call distribution server puts the call in a queue. *See Kelly, col. 15, line 54-col. 16, line 25.* Kelly discloses that the automatic call distribution server may transmit audio messages such as advertisements to the caller process while the call is in the queue; however, the messages are transmitted only to the caller process. Furthermore, the automatic call distribution server only receives the caller process information as a result of the packet exchange between them. *See Kelly, col. 15, line 54-col. 16, line 26-67.* Kelly fails to disclose or suggest a commercial message server, and in particular, Kelly fails to disclose a commercial message server having a telephony connection server interface to receive connection information from a telephony connection server.

Therefore, Kelly does not anticipate the independent claim 41 and consequently the dependent claims 42-43, and 45.

#### **CLAIMS 47, 51, and 52**

With respect to the Examiner's rejection of claims 47, 51, and 52, Applicants respectfully submit that Kelly does not teach "a telephony connection server comprising ... an advertisement service."

Kelly states "ACD server 500 ... may transmit periodic audio messages ... and other information such as music, advertisements, stock, quotes, etc." (Kelly, Col. 16 lines 25-29). This is the only passage in Kelly that refers to advertisements and it teaches that the ACD server is the transmitter of advertisements. Even so, the Kelly reference does not disclose an advertisement service.

Kelly also states, "...ACD server 300 does not actually duplicate the connection server functionality. Instead, ACD server 300 may be configured to invoke the services of connection server 252, as needed." (Kelly, Col. 11, lines 27-30).

Kelly does not teach that the connection server comprises an advertisement service. Instead, the only Kelly reference to advertisements is that the ACD server may transmit advertisements. Additionally, Kelly discloses the ACD server does not duplicate the connection server functionality. Therefore, Kelly does not disclose "a telephony connection server comprising ... an advertisement service" and does not anticipate claims 47, 51, and 52.

### **CLAIM 53**

With respect to the Examiner's rejection of claim 53. Applicants respectfully submit that Kelly does not disclose a merchant record for identifying a merchant corresponding to the commercial messages.

The Examiner argued on page 6 of the Office Action that "Kelly teaches a memory for storing commercial messages comprising: a sales group (merchant record) for identifying a merchant corresponding to the commercial messages (Col. 16, lines 1-5 and 21-24)."

In Kelly, the caller transmits a CONNECTREQ packet to the connection server. In response, the connection server transmits a CONNECTACK packet to the caller. With this exchange of packets, the caller is able to obtain a reference to the appropriate group organization serviced by an Automatic Call Distribution server, such as "sales@company.com" and is

provided with the Internet Protocol address of the Automatic Call Distribution server by the connection server. (See Kelly, Col. 15 line 60 through Col. 16 line 4).

Kelly states, "Next, if the split queues within the ACD server 500 are not full, ACD server 500 sends an ANSWER packet to caller process 500, as illustrated by transmission 7, and places the call on the "sales" queue for servicing by an agent." (Kelly, Col. 16, lines 21-24).

These references cited by the Examiner and the entire Kelly reference do not disclose commercial messages nor do they disclose a merchant record for identifying a merchant corresponding to the commercial messages. Therefore, Kelly does not anticipate claim 53.

#### **CLAIM REJECTIONS – 35 U.S.C. § 103(a)**

**Rejections under 35 U.S.C. §103(a) for obviousness by combining U.S. Patent No. 5,999,965 (Kelly) & U.S. Patent No. 6,285,364 (Giordano)**

#### **CLAIMS 3-7, 24-25, and 31-34**

The Examiner rejected claims 3-7, 24-25, and 31-34 under 35 U.S.C. § 103(a) as being unpatentable over Kelly in view of Giordano. The Applicants respectfully disagree.

The Applicants submit that claims 3-7 are allowable as being dependent on claim 1 and claims 31-34 are allowable as being dependent on claim 30.

With respect to claims 24 and 25, the Examiner stated, "Kelly does not teach the following limitation: "a speed dial key." In addition, contrary to the Examiner's argument, Kelly does not teach "receiving a commercial message having a speed dial key program." The Examiner cites to col. 16, lines 25-32 as subject matter that discloses "receiving a commercial message having a speed dial key program." However, that passage teaches neither receiving a commercial message, nor a commercial message having a speed dial key program. Applicants respectfully note that the Examiner correctly noted that Kelly does not teach a "speed dial key."

It must therefore follow that Kelly does not teach "receiving a commercial message having a speed dial key program."

Therefore, Applicants respectfully submit that the Examiner has failed to make a prima facie case of obviousness with regards to claims 24 and 25 and that claims 3-7, 24-25, and 31-34 should be allowed.

**Rejections under 35 U.S.C. §103(a) for obviousness by combining U.S. Patent No. 5,999,965 (Kelly), U.S. Patent No. 6,285,364 (Giordano), and U.S. Patent No. 6,275,574 (Oran)**

#### **CLAIMS 8 and 35**

The Examiner rejected claims 8 and 35 under 35 U.S.C. § 103(a) as being unpatentable over Kelly in view of Giordano, and further in view of Oran, U.S. Patent Number 6,275,574 (hereinafter Oran). Applicants respectfully submit that claims 8 and 35 are allowable as being dependent on independent claims 1 and 30 respectively.

**Rejections under 35 U.S.C. §103(a) for obviousness by combining U.S. Patent No. 5,999,965 (Kelly) and U.S. Patent No. 6,275,574 (Oran)**

#### **CLAIMS 11-16 and 18-19**

The Examiner rejected claims 11-16 and 18-19 under 35 U.S.C. § 103(a) as being unpatentable over Kelly in view of Oran. Applicants respectfully submit that claims 11-16 and 18-19 are allowable as being dependent on independent claim 1.

#### **CLAIMS 39-40**

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The Examiner rejected claims 39-40 under 35 U.S.C. § 103(a) as being unpatentable over Kelly in view of Oran. Applicants respectfully submit that claims 39 and 40 are allowable as being dependent on independent claim 30.

#### **CLAIM 44**

The Examiner rejected claim 44 under 35 U.S.C. § 103(a) as being unpatentable over Kelly in view of Oran. Applicants respectfully submit that claim 44 is allowable as being dependent on independent claim 41.

**Rejections under 35 U.S.C. §103(a) for obviousness by combining U.S. Patent No. 5,999,965 (Kelly) and U.S. Patent No. 4,850,007 (Marino)**

#### **CLAIMS 21 and 46**

The Examiner rejected claims 21 and 46 under 35 U.S.C. § 103(a) as being unpatentable over Kelly in view of Marino et. al., U.S. Patent Number 4,850,007 (hereinafter Marino). Applicants respectfully submit that claims 21 and 46 are allowable as being dependent on independent claims 20 and 41 respectively.

#### **SUMMARY:**

Applicants respectfully submit that, in view of the remarks above, the present application, including claims 1-16, 18-47, and 51-57, is now in condition for allowance and solicit action to that end.



If there are any matters that may be resolved or clarified through a telephone interview,  
the Examiner is respectfully requested to contact Applicants' undersigned representative.

Respectfully submitted,  
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**APPENDIX A**

Marked-up version of the claims indicating amendments where deletions are shown by brackets and additions are shown by underlining:

1. **(Amended)** A system for providing advertising on a data network telephony system comprising:

a data network to provide data connectivity for a plurality of data communications channels using data transport protocols;

a commercial message server [connected to the data network, the commercial message server] being operable to send at least one commercial message;

a first and second data network telephone connected to the data network, each data network telephone operable to communicate voice signals as data packets on a voice over data channel, the voice over data channel being one of the plurality of data communications channels on the data network containing packetized voice signals, the data network telephones being operable to convert data packets communicated on the voice over data channel to voice;

a network telephony connection server being operable to provide telephony service to data network telephones and communicate at least one commercial message request with the commercial message server; and

the first data network telephone being operable to receive the commercial messages while communicating voice signals as data packets, the first data network telephone further comprising a message display device to display the commercial messages.

20. **(Amended)** A method for advertising on a telephony system, the method comprising the steps of:

receiving a request to initiate a telephone call between a first data network telephone to a second data network telephone over a data network, the first and second data network telephones having a display screen, the request containing a caller user identifier to identify a [first] user of the first data network telephone, and a callee user identifier to identify a user of the second data network telephone;

communicating a commercial message request to a commercial message server;  
retrieving at least one commercial message from the commercial message server;  
sending the at least one commercial message to the first data network telephone; and  
receiving the at least one commercial message at the first data network telephone while the first data network telephone is communicating voice signals as data packets.

26. (Amended) A method of providing advertising services comprising the steps of:  
storing at least one [merchant] commercial message in a commercial message database;  
communicating with a telephony service provider to receive connection information, the connection information including at least a user identifier corresponding to a user of a data network telephone,

sending at least one commercial message request;  
sending at least one commercial message to the data network telephone while the data network telephone is communicating voice signals as data packets; and  
displaying the commercial message at the data network telephone.

30. (Amended) A voice communication device comprising:

a network interface to communicate using at least one data communications channel over a data network, the data communications channel including at least one voice over data communications channel;

a voice over data processor to convert voice signals to voice over data signals, and to convert voice over data signals to voice signals, the voice over data signals being communicated on the voice over data communications channel;

a signaling stack to send a request comprising a callee identifier to initiate a telephone call and to send a response to a received request to initiate a telephone call from another voice communications device; and

a message display device to display at least one commercial message received over the data network while the voice communications device is communicating the voice over data signals on the voice over data communication channel.